MCCURRY RESTAURANT (KL) SDN BHD

v.

MCDONALD'S CORPORATION

COURT OF APPEAL, PUTRAJAYA
GOPAL SRI RAM JCA
HELILIAH MOHD YUSOF JCA
SULONG MATJERAIE JCA
[CIVIL APPEAL NO: W-02-1037-2006]
27 APRIL 2009

***TRADE MARKS**: Passing off - Similarity in trade names - Plaintiff's "McDonald's" as against defendant's "McCurry" - Usage of prefix "Mc" - Whether there was similarity in get-up - Whether different types of food served - Whether different sets of customers patronising outlets - Whether public would presume plaintiff associated with defendant - Whether defendant sought to obtain unfair advantage from usage of prefix - Whether learned judge erred to assume plaintiff had monopoly in usage of prefix*

***TORT:** Passing off - Name of business - Plaintiff's "McDonald's" as against defendant's "McCurry" - Usage of prefix "Mc" - Whether public would presume plaintiff associated with defendant - Whether defendant sought to obtain unfair advantage from usage of prefix*

The plaintiff, the respondent herein, was the proprietor and operator of McDonald's chain of restaurants worldwide. The defendant, the appellant herein, offered Indian and other Malaysian cuisine under the name of "Restoran McCurry" or "McCurry Restaurant". The plaintiff successfully brought an action against the defendant for passing off in relation to the defendant's usage of the prefix "Mc" (See High Court case [2008] 9 CLJ 254]. Hence, the defendant's appeal.

Held (allowing the appeal)
Per Gopal Sri Ram JCA delivering the judgment of the court:

(1) The defendant's presentation of its business was in a style and get-up distinctively different from that of the plaintiff. The plaintiff's get-up consisted of a distinctive golden arched "M" with the word "McDonald's" against a red background. The

A defendant's signboard carried the words "Restoran McCurry" with the lettering in white and grey on a red background with a picture of a chicken giving a double thumbs-up and the wordings "Malaysian Chicken Curry". (para 13)

B **(2)** The items of food available at the plaintiff's outlets all carried the prefix "Mc" whilst none of the items served at the defendant's outlet carried the prefix as evident from the defendant's menu card. The type of food available at the plaintiff's outlets too differed from that of the defendant's. The C latter served only typical Indian food whilst the former served fast food. (paras 13)

(3) The learned judge was wrongly influenced by the decision of the hearing officer in the United Kingdom Trade Mark D Registry, *ie, In the Matter of Application No. 1412458* to register the mark "McIndian" (the '*McIndian* case'). Although the hearing officer found for McDonald's on the ground that McIndian could be confusingly similar to the McDonald's family of marks all employing the prefix "Mc", the learned E judge herein appeared to have overlooked the fact that McIndian not only sold Indian food but also Southern fried chicken, cheeseburgers, French fries and shakes which were the very items that McDonald's sold. That point was well brought out by the Singapore Court of Appeal in *McDonald's Corp v. Future Enterprises Pte Ltd* when distinguishing the F *McIndian* case from *Yuen Yu Kwan Frank v. McDonald's Corporation*. The court disregarded the objection by McDonald's and allowed the registration of the mark "McChina". Therefore, the learned judge's omission to distinguish the facts of the *McIndian* case from the facts of the G case herein constituted a serious misdirection resulting in a miscarriage of justice. (para 13)

(4) The type of customers who patronised the defendant's outlet was very different from those who patronised the plaintiff's H several outlets. The former were mainly adults and senior citizens while the latter were mainly children. The irresistible inference to be drawn from the totality of the evidence was that the defendant's signboard would not result in reasonable persons associating McCurry with the plaintiff's McDonald's I mark. (para 13)

(5) The facts showed that the defendant did not use the prefix "Mc" to food items served in its outlet contrary to what was held by the learned judge. The food items the defendant offered to its customers were wholly different from those offered by the plaintiff. The learned judge erred to assume that the respondent had a monopoly in the usage of the prefix "Mc" on a signage or in the conduct of business. If in *Yuen Yu Kwan Frank v. McDonald's Corporation*, a restaurant named "McChina" could carry on its business of selling only Chinese food, then there was no logic in restraining the appellant from selling only Indian food under the signage "McCurry". Given the totality of the circumstances of the case, the finding by the learned judge that the continued use by the appellant of the signage "McCurry" would create an association with the plaintiff, was a serious misdirection on the facts. (para 15)

(6) The fact that the defendant chose the name "McCurry" could not by itself lead to the inference that it sought to obtain an unfair advantage from the usage of the prefix "Mc". It would have been different if the defendant had offered its customers items labeled either the same or similar to those sold by the plaintiff. Accordingly, the learned judge misdirected herself on the proper inferences to be drawn from proved and admitted facts. (para 16)

(7) A reasonable tribunal armed with the facts and evidence that was presented to the learned judge would have held for the defendant and against the plaintiff. There was no proof of the tort of passing off and there was no judicial appreciation of the most important pieces of the evidence presented at the trial. (para 17)

Bahasa Malaysia *Translation Of Headnotes*

Plaintif, yang merupakan responden dalam kes ini, ialah tuan punya dan pengendali rangkaian restoran McDonald's di seluruh dunia. Defendan, perayu dalam kes ini, menawarkan masakan India dan masakan Malaysia lain di bawah nama "Restoran McCurry" atau "McCurry Restoran". Plaintif berjaya membawa suatu tindakan terhadap defendan untuk kelirupaan berhubungan dengan penggunaan kata awalan "Mc" oleh defendan (Lihat kes Mahkamah Tinggi [2008] 9 CLJ 254). Maka, rayuan ini oleh defendan.

Diputuskan (membenarkan rayuan)
Oleh Gopal Sri Ram HMR menyampaikan penghakiman mahkamah:

(1) Persembahan perniagaan defendan olehnya ialah dalam stail dan penghiasan yang jelas berbeza dari yang digunakan oleh plaintif. Penghiasan plaintif terdiri daripada "M" melengkung yang berwarna emas dengan perkataan "McDonald's" terhadap suatu latarbelakang merah. Papan tanda defendan mempunyai perkataan "Restoran McCurry" dengan penulisan huruf dalam putih dan kelabu atas suatu latarbelakang merah dengan gambar seekor ayam menunjukkan tanda "double thumbs-up" dengan perkataan "Malaysian Chicken Curry".

(2) Item-item makanan yang terdapat di tempat-tempat makanan plaintif semuanya mempunyai kata awalan "Mc" sementara tiada mana-mana item yang dihidangkan di tempat makanan defendan mempunyai kata awalan seperti yang dibuktikan dari kad menu defendan. Jenis makanan yang terdapat di tempat-tempat makanan plaintif juga berbeza daripada yang terdapat di tempat-tempat makanan defendan. Yang kedua hanya menghidangkan makanan India biasa sementara yang pertama menghidangkan makanan segera.

(3) Yang arif hakim telah salah dipengaruhi oleh keputusan pegawai pembicaraan dalam Pejabat Pendaftaran Cap Dagang United Kingdom, iaitu, *In the Matter of Application No. 1412458 to register the mark "McIndian"* (kes '*McIndian*'). Walaupun pegawai pembicaraan memihak pihak McDonald's atas alasan bahawa McIndian mungkin boleh mengakibatkan kekeliruan kerana serupa dengan cap sekeluarga McDonald's yang menggunakan kata awalan "Mc", hakim yang arif dalam kes semasa nampaknya tidak mempertimbangkan fakta bahawa McIndian bukan sahaja menjual makanan India tetapi juga ayam goreng Selatan, burger keju, kentang goreng dan susu kocak yang mana merupakan item-item yang sama yang dijual oleh McDonald's. Perkara itu telah dikemukakan dengan bagus oleh Mahkamah Rayuan Singapura dalam *McDonald's Corp v. Future Enterprises Pte Ltd* apabila membezakan kes *McIndian* daripada *Yuen Yu Kwan Frank v. McDonald's Corporation*. Mahkamah itu tidak mengendahkan bantahan oleh McDonald's dan telah membenarkan pendaftaran cap "McChina". Oleh itu,

peninggalan yang arif hakim untuk membezakan fakta kes *McIndian* dari fakta kes ini menyebabkan suatu salah arah serius yang mengakibatkan suatu salah laksana keadilan.

(4) Jenis pelanggan yang melanggan di tempat-tempat makanan defendan sangat berbeza daripada pelanggan yang melanggan di tempat-tempat makanan plaintif. Yang pertama kebanyakannya ialah orang dewasa dan warga tua sementara yang kedua kebanyakannya kanak-kanak. Inferens yang tidak dapat dibendung daripada keseluruhan keterangan ialah bahawa papan tanda defendan tidak akan menyebabkan orang-orang munasabah mengaitkan McCurry's dengan cap McDonald's plaintif.

(5) Fakta-fakta menunjukkan bahawa defendan tidak menggunakan kata awalan "Mc" untuk item makanan yang dihidangkan yang bertentangan dengan dapatan yang dibuat oleh yang arif hakim. Item makanan yang ditawarkan oleh defendan kepada pelanggannya berlainan sepenuhnya daripada item yang ditawarkan oleh plaintif. Yang arif hakim khilaf dalam menganggap bahawa responden mempunyai monopoli dalam penggunaan kata awalan "Mc" atas tanda atau dalam pengurusan bisnes. Kalau dalam *Yuen Yu Kwan Frank v. McDonald's Corporation*, sebuah restoran bernama "McChina" boleh meneruskan perniagaan menjual makanan Cina sahaja, tidak logik untuk menyekat perayu daripada menjual makanan India sahaja di bawah tanda "McCurry". Memandangkan keseluruhan halkeadaan dalam kes ini, dapatan yang arif hakim bahawa penggunaan berterusan tanda "McCurry" oleh perayu akan mewujudkan suatu kaitan dengan plaintif, merupakan suatu salah arah serius atas fakta-fakta.

(6) Fakta bahawa defendan telah memilih nama "McCurry" tidak begitu sahaja boleh membawa kepada inferens bahawa ia cuba untuk mendapat suatu kelebihan yang tidak adil dari penggunaan kata awalan "Mc". Ia akan berbeza jika defendan telah menawarkan pelanggannya item-item yang dilabel sama ada sama atau serupa dengan item yang dijual oleh plaintif. Oleh sebab itu, yang arif hakim telah menyalaharahkan dirinya atas inferens yang patut dibuat dari fakta-fakta yang diakui dan dibukti.

A (7) Suatu tribunal munasabah yang mempunyai fakta-fakta dan keterangan yang telah dikemukakan kepada yang arif hakim akan membuat keputusan yang berpihak kepada defendan dan menentang plaintif. Tiada apa-apa bukti tort kelirupaan dan tidak ada pertimbangan kehakiman keterangan-keterangan yang
B paling mustahak yang dikemukakan di perbicaraan.

Case(s) referred to:

Erven Warnink BV v. Townend & Sons (Hull) Ltd [1979] 2 All ER 927 ***(refd)***

McDonald's Corp v. Future Enterprises Pte Ltd [2005] 1 SLR 177 ***(refd)***

C *Mun Loong Co Sdn Bhd v. Chai Tuck Kin [1982] CLJ 80; [1982] CLJ (Rep) 590 HC* ***(refd)***

Perry v. Truefitt [1842] 49 ER 749 ***(refd)***

Reckitt & Colman Products Ltd v. Borden Inc [1990] 1 All ER 873 ***(refd)***

Tattinger SA v. Allbev Ltd [1993] FSR 641 ***(refd)***

D *Yuen Yu Kwan Frank v. McDonald's Corporation [2001] WL 1422899* ***(refd)***

For the appellant - Sri Dev Nair; M/s Sri Dev & Naila

For the respondent - SF Wong (S Indran with him); M/s Shearn Delamore & Co

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[Appeal from High Court, Kuala Lumpur; Civil Suit No: D6-22-989-2001]

Reported by Usha Thiagarajah

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JUDGMENT

Gopal Sri Ram JCA:

[1] Let me begin with the parties to this litigation. The plaintiff
G (respondent before us) is a fast food franchisor. It has outlets are all over the globe. Everyone knows or has heard of "McDonalds". There are several distinguishing marks or features about the way in which it conducts its trade. I will deal with these in a moment. The defendant (appellant before us) runs a fast food outlet. It is
H called "Restoran McCurry" or "McCurry Restaurant". It offers Indian and other Malaysian cuisine. It does not serve any of the kind of food available at the plaintiff's outlets. The plaintiff's complaint is that the defendant has passed off the plaintiff's business as its own. In its pleaded case it says that the defendant
I with full knowledge of the plaintiff's proprietary rights in the goodwill and reputation of its trade and business in food and beverages, conducted under the distinctive "Mc" identifier, copied

and adopted the identifier "Mc" for its own food and beverages restaurant. In elaboration of its claim, the plaintiff has in its written argument before us cited several examples. They are, McChicken, McMuffin, McRendang, McValue meals, McNuggets, McCrispy, McEgg, McMonday, McTwist, McWings, McSausage, McSpaceship, McTeddy Bears, McCafe, MvWatchables, McWednesday and McNews.

[2] The issue at trial was whether the defendant had passed off the plaintiff's business as its own. The learned judge held for the plaintiff. Her decision has been challenged in this appeal. But before I deal with the arguments addressed to us, it is necessary to say a few words about the cause of action relied upon by the plaintiff. It is based on the tort of passing off.

[3] Historically speaking, the starting point in a discussion of the tort is the judgment of Lord Langdale MR in *Perry v. Truefitt* [1842] 49 ER 749. The Master of the Rolls formulated the tort in this way:

> A man is not to sell his own goods under the pretence that they are the goods of another man; he cannot be permitted to practice such a deception, nor, to use the means which contribute to that end. He cannot therefore be allowed to use names, marks, letters or other indicia by which he may induce purchasers to believe that the goods which he is selling are the manufacture of another person. I own it does not seem to me that a man can acquire property merely in a name or mark; but whether he has or not a property in the name or the mark, I have no doubt that another person has not a right to use that name or mark for the purposes of deception, and in order to attract to himself that course of trade, or that custom, which, without that improper act, would have flowed to the person who first used, or who was alone in the habit of using the particular name or mark.

[4] Notice that the judgment speaks of passing off the goods of another. That is because the words were uttered when the tort was in an embryonic state, with commerce and industry at very basic levels. But the common law is not static. It does not rest upon a Procrustean bed. It is organic. And flexible. It grows to meet changing conditions with dynamism. So, as the nature of trade and commerce developed, so did the tort. As persons found new ways committing "theft" of intellectual property, the common law rose to the challenge. This was indeed recognised by Lord Diplock in the leading case of *Erven Warnink BV v. Townend & Sons (Hull) Ltd* [1979] 2 All ER 927, who said:

> Unfair trading as a wrong actionable at the suit of other traders who thereby suffer loss of business or goodwill may take a variety of forms, to some of which separate labels have become attached in English law. Conspiracy to injure a person in his trade or business is one, slander of goods another, but the most protean is that which is generally and nowadays, perhaps misleadingly described as passing off. *The forms that unfair trading takes, will, alter with the ways in which trade is carried on and business reputation and goodwill acquired.* (emphasis added.)

[5] The modern re-statement of the tort is to be found in the judgment of Sir Thomas Bingham MR in *Tattinger SA v. Allbev Ltd* [1993] FSR 641:

> But it is now, as I understand, clear that the defendant need not, to be liable, misrepresent his goods to be those of the Plaintiff if he misrepresents his goods or his business as being in some way connected or associated with the Plaintiff's.

[6] Learned counsel on both sides referred to the ingredients of the tort. They said that the tort comprises of five elements, all of which must be present for its proof. These are as follows:

(i) There must be a misrepresentation by the defendant;

(ii) It must be made in the course of trade;

(iii) It must be made to prospective or ultimate customers;

(iv) It must be calculated to injure the goodwill and reputation of the plaintiff;

(v) The plaintiff must suffer resultant damage.

Learned counsel for the plaintiff relied on the decision in *Erven Warnink* in support of his submission.

[7] Learned counsel for the defendant referred us to *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] 1 All ER 873, in particular to the speech of Lord Oliver when making his submission on the ingredients of the tort. This is what Lord Oliver said:

> The law of passing off can be summarised in one short general proposition, no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the Plaintiff in such an action has to prove in order to succeed. These are three in number. First, he must establish a goodwill or reputation attached to the goods or services which he

> supplies in the mind of the purchasing public by association with the identifying 'get up' (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Second, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the Plaintiff. Whether the public is aware of the plaintiff's identity as the manufacturer or supplier of the goods or services is immaterial, as long as they are identified with a particular source which is in fact the plaintiff. For example, if the public is accustomed to rely on a particular brand name in purchasing goods of a particular description, it matters not at all that there is little or no public awareness of the identity of the proprietor of the brand name. Third, he must demonstrate that he suffers or, in a *quia timet* action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the Plaintiff.

[8] With great respect to the learned Law Lords whose speeches were read to us, I find myself in the unfortunate position of entertaining a view that differs from theirs. In my judgment, since passing off is a common law wrong, it is idle to speak of the ingredients of the tort in strict terms as though it was a creation of some penal statute. It is not. At the risk of repetition, it is a product of the genius of the common law. But, that said, the elements referred to in the two cases already cited are certainly the essential features of the tort in the sense in which it has always been understood. Put shortly, a defendant is liable if he injures the plaintiff by either passing off his goods or mark or business as that of the plaintiff's. And to pass off one as the other certainly involves the creation of a false impression which is referred to as the element of misrepresentation in the tort. For my part, I am content to rely upon and be guided by the following passage in the judgment of Mohamed Azmi J (later FCJ) in *Mun Loong Co Sdn Bhd v. Chai Tuck Kin* [1982] CLJ 80; [1982] CLJ (Rep) 590:

> At common law, it is an actionable tort for one person to represent his business to be that of another, or to mislead the public into believing that it is, because the person guilty of the deception thereby profits illegitimately from the goodwill which attaches to the other business. The commonest means by which this deception is practised is by the adoption of a business name which is calculated to cause the public to confuse the spurious business with the genuine one. If the spurious business is conducted by a company incorporated with a name likely to cause such confusion, the owner of the genuine business may obtain an injunction to restrain the company from trading in its own name or even continuing to have its own name. If the injunction takes the latter form, the company must either change its name or be wound up.

[9] That brings me to the question argued at length before us as to whether there exists the "extended tort of passing off". We were regaled with authorities on both sides in support of their rival submissions. It is clear that the defendant apprehends the point of origin of the so-called extended tort to be the speech of Lord Fraser of Tullybelton in *Erven Warnink*. It is the defendant's submission that Lord Fraser had held that the tort of passing off could be established without proof of a misrepresentation and that this was not the law. According to the defendant, the plaintiff succeeded in the court below on this extended form of the tort without having pleaded it. This is a point I will deal with in a moment. But I must first deal with the defendant's complaint that Lord Fraser was wrong in holding that a plaintiff could succeed without proof of misrepresentation when what is at issue is injury to goodwill.

[10] Now, here is what that learned Law Lord said:

> It is essential for the plaintiff in a passing-off action to show at least the following facts: (1) that his business consists of, or includes, selling in England a class of goods to which the particular trade name applies; (2) that the class of goods is clearly defined, and that in the minds of the public, or a section of the public, in England, the trade name distinguishes that class from other similar goods; (3) that because of the reputation of the goods there is goodwill attached to the name; (4) that he, the plaintiff, as a member of the class of those who sell the goods, is the owner of goodwill in England which is of substantial value; (5) that he has suffered, or is really likely to suffer, substantial damage to his property in the goodwill by reason of the defendants selling goods which are falsely described by the trade name to which the goodwill is attached.

[11] I have read and re-read the speech of Lord Fraser and nowhere do I find in it any pronouncement dispensing with the proof of the element of misrepresentation. Indeed, it is manifestly clear from the passage above quoted that the misrepresentation by the defendant of his goods or business as that of the plaintiff's is an essential element of the tort. This is clear from the phrase "falsely described". It is elementary that to falsely describe is to misrepresent. I am therefore inclined to agree with the submission of counsel for the plaintiff that the so-called extended tort is nothing more than the common law adapting the tort of passing off to new and different circumstances. And, as for the pleading point, there is really nothing in it at all. In the first place the plaintiff has in its statement of claim pleaded all the facts that go to constitute the elements of the tort. In the second place, whether the plaintiff may rely on the so called extended form of the tort is a question of law and it is well settled that you do not have to plead law.

[12] I come now to what I consider to be the nub of the case. It is whether the learned judge judicially appreciated the evidence before her in holding that the defendant had committed the tort against the plaintiff. From the way in which the plaintiff ran its case in the court below and when responding to the appeal, the only point that survives is whether the use by the defendant of the word "McCurry" amounts to a passing off by it of the plaintiff's trade name to which goodwill is attached. Put differently, the question is: Did the defendant represent his business to be that of the plaintiff? Having scrutinised the evidence presented to the learned trial judge, I have come to the conclusion that the question must receive a negative response. And I will explain why.

[13] First, you have to look at the plaintiff's mark or get-up or logo – call it what you will – as a whole and not merely one element in it. The plaintiff's get-up consists of a distinctive golden arched "M" with the word "McDonalds" against a red background. The defendant's signboard carries the words "Restoran McCurry" with the lettering in white and grey on a red background with a picture of a chicken giving a double thumbs up and with the wording "Malaysian Chicken Curry". Thus, the defendant's presentation of its business is in a style and get up which is distinctively different from that of the plaintiff. Second, as I have already said, the items of food available at the plaintiff's outlets all carry the prefix "Mc". However, as evident from the

defendant's menu card none of the food items served carries the prefix Mc. This is an important consideration. Third, it is beyond dispute that the type of food available at the plaintiff's outlets is very different from that served at the defendant's sole outlet. The latter caters only typically Indian food whereas the former serves fast food. This is an important point in the defendant's favour. The learned trial judge in her judgment appears to have been influenced by the decision of the Hearing Officer in the United Kingdom Trade Mark Registry, in the Matter of Application no. 1412458 by Sabbir Mehta, Osman Mehta, Imtiaz Ahmed Mulla and Hanif Patel to Register the mark McIndian. There, the Hearing Officer found for McDonalds on the ground that McIndian could be confusingly similar to the McDonald's family of marks all employing the prefix "Mc". However, what the learned trial judge in the present instance appears to have overlooked is the fact that McIndian not only sold Indian food, but also Southern fried chicken, cheeseburgers, French fries and shakes which are the very items that McDonalds also sell. This point is well brought out by the Singapore Court of Appeal in *McDonald's Corp v. Future Enterprises Pte Ltd* [2005] 1 SLR 177 when distinguishing the *McIndian* case from *Yuen Yu Kwan Frank v. McDonald's Corporation* [2001] WL 1422899 where the court disregarded the objection of McDonald's and allowed the registration of the mark "McChina". In my judgment, the learned judge's omission to distinguish the facts of the *McIndian* case from the present instance constitutes a serious misdirection which has resulted in a miscarriage of justice. The fourth, point I would make is this. There is evidence to show that the type of customers who patronise the defendant's outlet is very different from those who patronise the plaintiff's several outlets. The former are in the main adults and senior citizens while the latter are mainly children. In my judgment the irresistible inference to be drawn from the totality of the evidence is that the defendant's signboard would not result in reasonable persons associating McCurry with the plaintiff's mark. The one is a typically Indian restaurant selling Indian and local dishes with just its one outlet while the other is a multinational vendor of fast food such as burgers, French fries and milkshakes.

[14] In the course of her judgment the learned judge made the following observations on which comment is necessary:

> [56] When 'Mc' is used in conjunction with a food item, the first impression or the first thing that comes to mind is McDonald's and the plaintiff. Any unauthorized use of the prefix 'Mc' could also lead to the conclusion that the products sold and the services offered with reference to the said prefix are an extension of the plaintiff's family of mark consequently creating an association with the plaintiff.
>
> [57] Customers familiar with the McDonald's trade mark and corporate signage and the products found in the McDonald's outlets would only logically assume that 'Mc' in McCurry restaurant is associated in some way to the plaintiff or is an extension of the plaintiff's current range of products and services. It is also not a coincidence that the defendant would have picked the font and colour scheme on its signage without referring to the signage and repute of the plaintiff. I am of the view that this shows that the defendant seeks to obtain an unfair advantage from the usage of the prefix.

[15] In the first place, the learned judge's finding is postulated on the fact that the defendant used the prefix "Mc" – to quote her – "is used in conjunction with a food item". But the facts show that the defendant did not use the prefix "Mc" in conjunction with a food item. Indeed, as I have already said, the food items the defendant offers its customers are wholly different from those offered by the plaintiff. Where the learned judge, with respect, erred is to assume that the respondent had a monopoly in the use of the prefix "Mc" on a signage or in the conduct of business. If in *Yuen Yu Kwan Frank v. McDonald's Corporation* a restaurant could carry on a restaurant named "McChina" selling only Chinese food, it is a little difficult to fathom the logic of restraining the instant appellant from selling only Indian food under the signage "McCurry". Given the totality of the circumstances of this case, the finding by the learned judge that the continued use by the appellant of the signage "McCurry" would – again to quote her – "lead to the conclusion that the products sold and the services offered with reference to the said prefix are an extension of the plaintiff's family of mark consequently creating an association with the plaintiff" is a serious misdirection on the facts.

[16] With regard to the finding of the learned judge at para 57 of her judgment (above quoted), the fact that the defendant chose the name "McCurry" cannot by itself lead to the inference that it sought to obtain an unfair advantage from the usage of the prefix "Mc". It would have been different if the defendant had

A offered to its customers items that were labelled either the same as or similar to those sold by the plaintiff, for example, Mcfish or Mclamb. But that is not what the defendant did. Accordingly, it is my considered judgment that the learned judge misdirected herself on the proper inferences to be drawn from proved and
B admitted facts.

[17] In my judgment, a reasonable tribunal armed with the facts and evidence that was presented to the learned judge would have held for the defendant and against the plaintiff. This is because
C there was, in my respectful view, no proof of the tort of passing off in this case. And there was no judicial appreciation of the most important pieces of the evidence presented at trial.

[18] For the reasons already given, I would allow the appeal and reverse the findings of the learned judge. The plaintiff's claim is
D dismissed. The costs of this appeal and those incurred in the court below shall be borne by the plaintiff. The deposit shall be refunded to the defendant.

[19] My learned sister Heliliah bt Mohd Yusof and my learned
E brother Sulong Matjeraie, JJCA have seen this judgment in draft and have expressed their agreement with it.

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